

REMARKS

In the November 24, 2003 Office Action (hereinafter "Office Action"), Claims 1-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,794,207, to Walker et al. (hereinafter "Walker et al."). With this amendment and response, Claims 1-29 remain pending in the application, with Claims 1, 12, and 24 being independent claims.

Pursuant to 37 C.F.R. § 1.111 and for the reasons set forth below, applicants request reconsideration and allowance of this application. Prior to discussing the reasons why applicants believe that the present application is in condition for allowance, an Examiner's Interview Summary is presented, followed by brief descriptions of the present invention and the cited reference, Walker et al. The brief description of the present invention, as well as the teachings of Walker et al., are not provided to define the scope or interpretation of any of the claims of this application. Instead, such discussions are provided to help the U.S. Patent and Trademark Office better appreciate important claim distinctions discussed thereafter.

Examiner Interview Summary

Applicants would like to thank the Examiner for taking time on February 5, 2004, on February 10, 2004, and on February 24, 2004, to participate in telephone interviews. The interviews were conducted in light of the Office Action finally rejecting Claims 1-29.

Participating in the February 5, 2004 interview were Examiner Marissa Thein, Ms. Maria Anderson, and Mr. Tracy Powell. The discussion in the interview was directed particularly to Claims 1 and 6. In regard to Claim 1, on behalf of applicants, Ms. Anderson and Mr. Powell pointed out how Walker et al. fail to disclose all elements of Claim 1. In particular, Ms. Anderson and Mr. Powell pointed out that Walker et al. fail to disclose the following patentably distinguishable recitations of Claim 1:

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- a preferred provider group and a non-preferred provider group, both of which may have the opportunity to provide quotes to an offer;
- selecting a provider from the preferred provider group in attempting to satisfy the customer's offer;
- repeatedly selecting other providers from the preferred provider group if the previously selected preferred provider does satisfy the customer's offer; and
- attempting to satisfy the offer with the group of non-preferred providers after the group of preferred providers is exhausted without satisfying the customer's offer.

In regard to Claim 6, Ms. Anderson and Mr. Powell pointed out that Walker et al. fail to disclose the following patentably distinguishable recitation:

- evaluating multiple quotes provided by the selected preferred provider in descending order of value, from the highest quote to the lowest quote, and selecting the highest quote that satisfies the offer.

Examiner Thein mentioned that the method claims, Claims 1-11, should be amended to recite some structure so that the claims would be directed to statutory subject matter.

Participating in the February 10, 2004 telephone conference were Examiner Thein and Mr. Powell. There was some discussion as whether Ms. Anderson and Mr. Powell properly held power of attorney for this matter. Applicants subsequently submitted copies of previously filed documents establishing power of attorney in Ms. Anderson and Mr. Powell, as well as the USPTO's confirmation accepting those documents and establishing power of attorney. Applicants believe this issue is resolved.

Also in the February 10, 2004 telephone conference, Examiner Thein stated that, after conferring with other Examiners at the USPTO, little patentable weight is given to various clauses recited in Claim 1. In particular, Examiner Thein stated that little patentable weight is given to so-called "if ... then" clauses, such as found in Claim 1, because they claim alternatives

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and are open ended. Apparently, as little patentable weight is given to such clauses/recitations, the second group of providers, more particularly the non-preferred provider group recited in Claim 1, was essentially disregarded. In light of this evaluation/interpretation of the claims, Examiner Thein recommended that the claims be modified to recite the clauses in a more positive manner. Mr. Powell requested a citation, either statutory or case law, in support of the assertion that "if ... then" clauses may be given little patentable weight, to which Examiner Thein responded with MPEP § 2106, and *Cochrane v. Deener*, 94 U.S. 780 (1876).

Participating in the February 10, 2004 telephone conference were Examiner Thein and Mr. Powell. The topic was directed to the "if" clauses in claims. Mr. Powell mentioned that per his review of the MPEP § 2106, there is no statement that "if" recitations are to be given little patentable weight. Mr. Powell also submitted that *Cochrane* makes no such assertion. Mr. Powell then pointed out that at least two U.S. patents were recently issued, both having "if" clauses: U.S. Patent No. 6, 678,644 issued on January 13, 2004, and U.S. Patent No. 6,678,355 also issued on January 13, 2004. A request to speak with Examiner Thein and her supervisor was denied.

Brief Description of Applicants' Invention

The present invention provides a system and method for matching a customer's offer with a quote from a product provider. In accordance with the present invention, two groups of providers are identified. The first group, a preferred provider group, includes providers that have negotiated for, or somehow obtained, preferential treatment for responding to consumer offers. As members of the preferred provider group, preferred providers are given an exclusive opportunity to satisfy a consumer's offer prior to lesser-preferred and/or non-preferred providers. As a preferred provider is given an exclusive opportunity to satisfy a consumer's offer, a

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preferred provider does not expend precious resources in continually monitoring for such opportunities in order to beat out the competition (which is endemic to race-type systems).

According to the present invention and with respect to the preferred provider group, each preferred provider is ranked, or ordered, according to certain preference criteria. Preferred providers may negotiate for, or otherwise obtain, a higher preference ranking among the group of preferred providers. According to this ranking of preferred providers, when a consumer's offer is received, a preferred provider with a higher preference ranking is given an exclusive opportunity to respond to the offer before any preferred provider with a lower preference ranking may respond. Once a higher ranked preferred provider satisfies the consumer's offer, the consumer's offer is not made available to any lower ranked preferred providers, or to the non-preferred providers.

The second group of providers, the non-preferred provider group, includes those providers that can provide the goods sought for in the offer, but for whatever reason are not a member of the preferred provider group, i.e., receive no preferential, exclusive access to the offer. Non-preferred providers may satisfy a consumer offer only after all of the preferred providers fail to satisfy the consumer's offer. According to aspects of the present invention, providers included in the preferred provider group may also be included in the non-preferred provider group.

In operation, a system adapted according to the present invention receives a consumer's offer, the system first directs the consumer's offer to the preferred provider group. More particularly, the consumer's offer is presented to the preferred providers in the preferred provider group iteratively, beginning with the preferred provider with the highest ranking, and continuing to the preferred provider with the lowest ranking. At each iteration, the selected/current preferred provider is presented with the consumer's offer and quotes are obtained from that selected provider. If at least one quote from the selected preferred provider satisfies the

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consumer's offer, the system completes the transaction between the consumer and the selected preferred provider. Once the consumer's offer is satisfied, no further iteration to lesser preferred providers is made, nor is the consumer's offer made available to the non-preferred provider group.

Should each preferred provider in the preferred provider group fail to satisfy the consumer's offer, the system then makes the consumer's offer available to the non-preferred provider group. The non-preferred providers in the non-preferred provider group are not ranked. Thus, the consumer's offer is presented to the non-preferred group collectively, rather than iteratively. Should more than one non-preferred provider attempt to satisfy the consumer's offer, the system uses certain selection criteria to select a provider. Selection criteria may include any number of factors, such as maximizing profitability to the system, best competitive price to the consumer, or first provider to satisfy the offer. Other rules or factors may also be utilized.

According to additional aspects of the present invention, a preferred provider may submit multiple quotes to satisfy a consumer's offer. Upon receiving multiple quotes from a selected preferred provider, the system orders the quotes according to their value/cost, and selects the quote with the highest value that satisfies the consumer's offer.

Utilizing the present invention, providers can negotiate for a preferential access to consumer's offers. This creates an incentive for the providers to offer competitive products through the system. The system benefits by being able to maximize profits using the competitive offers from preferred providers, while still meeting the consumer's expectations. Consumers are also benefited as they receive the requested product at or below their offered price.

Brief Description of U.S. Patent No. 5,794,207 to Walker et al.

Walker et al. present a system for delivering buyer-driven commerce. Under the Walker et al. system, a consumer submits a conditional purchase offer for goods to a central controller.

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A conditional purchase offer (CPO) represents a consumer's commitment to purchase the goods specified in the CPO if a seller agrees to sell those goods according to the terms of the CPO (including price.) The central controller stores the consumer's CPO in a CPO database after the system has validated that the consumer is financially able to complete the transaction if accepted by a seller. The CPO database may be organized according to the CPO's identified product in order to facilitate the sellers to find those offers that are relevant to them.

According to Walker et al., those sellers that sell the goods identified in the CPO are notified of the new CPO. The sellers can then review the CPO in the CPO database. Any seller offering the sought-for goods may accept/fulfill the consumer's CPO in the CPO database. To fulfill the consumer's CPO, a seller returns a response to the system indicating the seller's desire to fulfill the CPO. As more than one seller may respond to the same CPO at approximately the same time, the system records the time at which a seller responds to a CPO. Clearly, as any seller may accept/fulfill a CPO, each seller is pressured to accept/fulfill the CPO as soon as possible. The seller that responds first to the CPO is selected to fulfill the CPO. In other words, the Walker et al. system is a first-to-respond, or race system.

Implicit with a first-to-respond/race system, such as disclosed by Walker, is the fact that a consumer's CPO is made available to all sellers at or about the same time. Thus, in clear contrast to the present invention, there is no selection of a preferred provider, and a consumer's CPO is not iteratively presented to individual sellers in a preferential order to give each seller a full opportunity to respond without immediate competition from other sellers. As the Walker et al. system is a first-to-respond system, Walker et al. would not, and do not, disclose ordering sellers for preferential treatment. In further contrast to the present invention, Walker et al. fail to disclose categorizing the sellers able to provide the sought-for goods into groups of preferred sellers and non-preferred sellers, opting instead to select a seller according to a first to accept/race system.

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Rejection of Claims Under 35 U.S.C. § 102(b)**Claim 1**

In regard to independent Claim 1, as amended, applicants respectfully submit that Walker et al. fail to disclose each element of this independent claim. In particular, Walker et al. fail to disclose the following elements:

"selecting a preferred provider from a group of preferred providers,"

"if the at least one quote from the selected preferred provider does not satisfy the offer, repeatedly: selecting another preferred provider from the group of preferred providers; obtaining at least one quote for the product from the selected preferred provider; and evaluating the at least one quote from the selected preferred provider to determine if the at least one quote satisfies the offer; until the offer is satisfied or until the group of preferred providers is exhausted," and

"if the group of preferred providers is exhausted without satisfying the offer, attempting to satisfy the offer from a group of non-preferred providers."

The Recitations of Claim 1 Are Definite and Carry Patentable Weight

In the telephone interview of February 10, 2004, the Examiner indicated that little patentable weight is given to claim recitations/clauses that begin with "if". Applicants have reviewed the MPEP § 2106, *Cochrane v. Deener*, 94 U.S. 780 (1876), as suggested by the Examiner, as well as major patent law treatises. In reviewing these references, applicants were unable to locate any statements suggesting that some claim recitations may be given little patentable weight because the recitation begins with "if." In fact, applicants assert that *Cochrane*, a copy of which is attached to this response, stands for the proposition that a process may be patentable irrespective of the structures in which it may be implemented, not that "if"

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recitations of a claim may be given less patentable weight or disregarded. Moreover, applicants are aware of at least two U.S. patents, issued in January of this year (2004), that include "if" clauses in the independent claims. (See, U.S. Patent No. 6,678,664 B1 to Ganesan, and U.S. Patent No. 6,678,355 B2 to Eringis et al., both issued on January 13, 2004.) Accordingly, applicants assert that the recitations of Claim 1, beginning with "if", represent valid claim elements regularly accorded patentable weight by the U.S. Patent and Trademark Office, and that disregarding these recitations simply because they begin with "if" is impermissible. Should the Examiner maintain her position with respect to the "if" recitations in the present claims, applicants respectfully request that binding authority be cited in support of this position.

Applicants also submit that the recitations of Claim 1 are both definite and clear. The first section of the claim generally includes the following steps: (1) receiving a customer offer, (2) selecting a preferred provider, (3) obtaining quotes from the preferred provider, and (4) evaluating the quotes to determine whether the quotes satisfy the offer. The next section of Claim 1 continues by reciting that "if" the results of the previous evaluation (step 4) determine that the quotes do not satisfy the offer, steps (1)-(4) are iteratively repeated for the remaining preferred providers in the preferred provider group until the preferred provider group has been exhausted or a selected provider satisfies the offer. The following section of Claim 1 further continues by stating that if the preferred provider group is exhausted without satisfying the consumer's offer, the system then presents the offer to the non-preferred providers in the non-preferred provider group. Claim 1 finishes by reciting that "if" the offer is satisfied, either by a preferred provider or a non-preferred provider, the purchase between the consumer and satisfying provider is negotiated. Applicants assert that Claim 1 clearly and unambiguously recites specific steps taken in any alternative case. Applicants, therefore, assert that Claim 1 is definite, and thus, each element of Claim 1 must be found in Walker et al. in order to form a proper 35 U.S.C. § 102 rejection. (See, *Transclear Corp. v. Bridgewood Services, Inc.*, 290 F.3d

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1364, 1370 (Fed. Cir. 2002), "35 U.S.C. § 102 requires a finding that each and every limitation is found either expressly or inherently in a single prior art reference.") (Emphasis added.)

Walker et al. Do Not Disclose a Preferred and Non-Preferred Provider Group

As a preliminary matter, Claim 1 recites a preferred provider group and a non-preferred provider group, both of which are capable of and are utilized to attempt to satisfy the consumer's offer. It is asserted in the Office Action that Walker et al. disclose both a preferred and non-preferred provider group: the preferred provider group being those sellers that sell the sought-for goods, and the non-preferred provider group being those sellers that do not sell the sought-for goods. However, under this definition of a preferred provider group, it would make absolutely no sense to present a consumer's offer to the non-preferred provider group, i.e., those sellers that do not sell the sought-for goods. Clearly, Walker et al. make no such disclosure. In contrast, Claim 1 recites that the consumer's offer is presented to both the preferred provider group and the non-preferred provider group. Thus, even if the group of sellers carrying the sought-for goods could be construed as a preferred provider group, which applicants expressly deny, Walker et al. clearly fail to disclose a non-preferred provider group from which the consumer's offer also may be satisfied.

Walker et al. Fail to Disclose "Selecting" a Preferred Provider

It is asserted in the Office Action that Walker et al., at Col. 9, lines 5-16, disclose "selecting a preferred provider from a group of preferred providers," stating that CPOs "are displayed globally such that it is available to be viewed by interested potential sellers." Applicants agree with the Office Action that Walker et al. disclose that CPOs are displayed globally such that any interested seller may view it. However, globally displaying a CPO is clearly and patentably distinct from the positive recitation of selecting a single preferred provider from the preferred provider group, as recited in Claim 1. In fact, Walker et al. teach away from selecting a single preferred provider, by globally presenting the CPO to any and all

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interested sellers. (See Col. 7, lines 34-35, and Col. 19, lines 23-25.) Applicants assert that Walker et al. clearly fail to disclose the positive step of selecting a preferred provider from a group of preferred providers.

Walker et al. Fail to Disclose "Repeatedly" Selecting Other Preferred Providers

It is asserted in the Office Action that Walker et al., at Col. 9, lines 5-16, and at Col. 17, lines 49-62, disclose repeatedly selecting another preferred provider from the group of preferred providers, obtaining at least one quote from the selected provider, and evaluating the at least one quote to determine at least one quote satisfies the offer, until the offer is satisfied or until the group of preferred providers is exhausted. Applicants disagree.

As mentioned above, Walker et al. make the buyer's CPO available to all potential sellers *en masse*. Indeed, Walker et al. fail to select a first preferred provider. As no first preferred provider is selected, Walker et al. cannot and do not disclose repeatedly selecting preferred providers from the preferred provider group. As such, Walker et al. also cannot disclose repeatedly selecting preferred providers until the offer is satisfied or the group of preferred providers is exhausted.

Walker et al. Fail to Disclose Attempting Satisfy the Offer With Non-Preferred Providers

It is asserted in the Office Action that Walker et al. disclose attempting to satisfy the offer from a group of non-preferred providers if the group of preferred providers is exhausted without satisfying the offer. The Office Action references Col. 10, lines 40-45 for support, stating that remote sellers "who normally would not be able to afford to find the buyer but who may be able to provide the buyer with the exact deal" represent the non-preferred provider group. Applicants disagree.

As discussed above, Walker et al. fail to disclose two groups of providers capable of responding to an offer. The remote sellers of Walker et al., per the Office Action's previous

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definition of a preferred provider group, must included the preferred provider group as the preferred provider group includes those sellers known to the Walker et al. system that can provide the sought-for goods. Obviously, the remote sellers are known to the system (or they would not be selected) and able to provide the goods. As such, they are part of the Office Action's definition of the preferred provider group. Clearly, the statement that remote sellers can now reach buyers is an expression, by Walker et al., of a benefit realized by the system, and is not a definition of a non-preferred provider group. Thus, applicants submit that Walker et al. completely fail to disclose turning to a non-preferred provider group when the group of preferred providers is exhausted without satisfying the offer.

For the reasons described above, applicants assert that Walker et al. fail to disclose each recitation of independent Claim 1. Accordingly, applicants respectfully request that the 35 U.S.C. § 102(b) rejection of Claim 1 be withdrawn and the claim allowed.

Claims 2-11

Claims 2-11 depend from Claim 1. Accordingly, for at least the same reasons described above in regard to Claim 1, applicants respectfully submit that Walker et al. fail to disclose each element of Claims 2-11, especially when read in conjunction with Claim 1. Accordingly, applicants request that the 35 U.S.C. § 102(b) rejections of Claims 2-11 be withdrawn and the claims allowed.

Claims 2-11 include additional recitations that further distinguish them from Walker et al., some of which are described below.

Claim 6

Applicants assert that Walker et al. fail to disclose each element of Claim 6. In particular, Walker et al. fail to disclose "evaluating the quotes provided by the selected preferred

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provider in descending order of value, from the highest quote to the lowest quote, and selecting the highest quote that satisfies the offer."

The Office Action refers to Col. 19, lines 13-60 as support for evaluating quotes provided by the selected preferred provider in descending order of value. Applicants disagree. As a preliminary matter, in the Walker et al. system, a seller either accepts or declines the buyer's CPO. Stated in another way, a seller must accept or decline the CPO on its defined terms. As such, a seller does not supply quotes because the price to be paid is fixed by the buyer. It would be of no value for a seller to provide multiple acceptances. Further, as acceptance is based on the terms of the CPO, there can be no evaluation of offers in descending order of value. Evaluating offers in descending order of value implies that offers may be different. However, Walker et al. do not disclose receiving differently valued acceptances because the CPO is either accepted or not on its defined terms.

The cited passage in Walker et al., Col. 19, lines 13-60, more accurately disclose that one or more sellers may respond to a CPO, that each responding seller is authenticated to validate that it can supply the sought for product, that the central server validates the status of the CPO, and that sellers may transmit their responses directly to the buyer. Applicants assert that neither this passage in Walker et al., nor any other passage in Walker et al., disclose evaluating multiple quotes in descending order of value, from highest to lowest, and selecting the highest quote that satisfies the offer.

For these additional reasons, applicants respectfully assert that Walker et al. fail to disclose each element of Claim 6. Accordingly, applicants respectfully request that the 35 U.S.C. § 102(b) rejection of Claim 6 be withdrawn, and the claim allowed.

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Claim 12

It is asserted in the Office Action that Walker et al. disclose each element of independent Claim 12. Applicants disagree. In particular, applicants assert that Walker et al. fail to disclose the following elements:

"ranking each preferred provider in a plurality of preferred providers according to a preferred criteria,"

"selecting a highest ranked preferred provider from the plurality of preferred providers," and

"attempting to match the offer from the customer with the highest ranked preferred provider by determining whether a quote obtained from the highest ranked preferred provider satisfies the preferred provider criteria associated with the highest ranked preferred provider." (Emphasis added.)

As previously discussed, Walker et al. fail to disclose a group of preferred providers. Walker et al. further fail to disclose ranking each preferred provider. The Office Action refers to Col. 9, lines 5-30, Col. 18, lines 27-31, and Col. 13, lines 35-38 as support of ranking each preferred provider according to a preferred criteria. However, applicants respectfully assert that Col. 9, lines 5-30 instead disclose that qualified sellers, i.e., those who have been authenticated as able to deliver the sought after product, may peruse the CPO database and respond to the central server to accept the offer. Column 18, lines 27-31 disclose that the Walker et al. system may implement its global broadcast of the CPOs to sellers, either individually or in groups. Column 13, lines 35-38 disclose that the seller response database tracks the sellers' responses, which may include a seller ID number. Clearly, none of these passages disclose any preference criteria. Furthermore, none disclose that the sellers are ranked according to this preference criteria.

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As Walker et al. clearly fail to disclose ranking the preferred providers according to preference criteria, it follows that Walker et al. must also fail to disclose selecting a highest ranked preferred provider. However, the Office Action refers to Col. 19, lines 13-28, and Col. 20, lines 5-15, as support for "selecting a highest ranked preferred provider." Column 19, lines 13-28, simply indicate that one or more sellers may attempt to bind the customer to an offer. Column 20, lines 5-15, disclose that for some CPOs it is desirable to receive responses from multiple sellers. These passages in Walker et al. clearly fail to disclose selecting a highest ranked preferred provider.

For the reasons described above, applicants respectfully submit that Walker et al. fail to disclose each element of independent Claim 12. Accordingly, applicants request that the 35 U.S.C. § 102(b) rejection of Claim 12 be withdrawn and the claim allowed.

Claims 13-23

Claims 13-23 depend from independent Claim 12. Accordingly, applicants submit that for the same reasons described above in regard to Claim 12, Walker et al. fail to disclose each element of Claims 13-23, especially when read in conjunction with independent Claim 12. Applicants therefore request that the 35 U.S.C. § 102(b) rejections of Claims 13-23 be withdrawn and the claims allowed.

In addition to the above-described reasons, many of these claims have additional elements that further distinguish them from Walker et al. Some of these claims are described below.

Claim 15

It is asserted in the Office Action that Walker et al. disclose each element of dependent Claim 15, particularly "attempting to match the offer with other preferred providers is performed in descending order of the ranking associated with each preferred provider." Applicants disagree.

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The Office Action cites Col. 19, lines 13-60, as support for rejecting Claim 15. However, this passage of Walker et al., described above, is directed at processing seller acceptances, not selecting providers. In other words, this passage of Walker et al. is directed to procedures taken after a buyer's CPO is matched/accepted by a seller. In clear contrast, Claim 15 is directed to attempting to match the offer with other preferred providers, i.e., before any offers are submitted.

Additionally, as discussed in regard to Claim 12, Walker et al. utterly fail to disclose any ranking among preferred providers. As Walker et al. fail to disclose any rankings among preferred providers, Walker et al. cannot and do not disclose repeatedly attempting to match the offer with other preferred providers in a descending order of the ranking of each preferred provider (as already discussed above in regard to Claim 1.) Accordingly, applicants request that the 35 U.S.C. § 102(b) rejection of Claim 15 be withdrawn and the claim allowed.

Claim 16

It is asserted in the Office Action that Walker et al. disclose each element of dependent Claim 15, particularly "attempting to match the offer with one of a plurality of non-preferred providers." Applicants disagree.

As previously discussed in regard to Claim 1, Walker et al. utterly fail to disclose two delineated groups of providers capable of providing the sought-for goods: a preferred provider group and a non-preferred provider group. Walker et al. further fail to disclose first attempting to satisfy the consumer's offer from the preferred providers, and subsequently "attempting to match the offer with one of a plurality of non-preferred providers," as recited in Claim 16. Accordingly, applicants request that the 35 U.S.C. § 102(b) rejection of Claim 16 be withdrawn and the claim allowed.

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Claim 24

It is asserted in the Office Action that Walker et al. disclose each element of independent Claim 24, and in particular:

"a travel server component configured to obtain at least one quote associated with each provider in a plurality of providers to provide the product at a cost, **the plurality of providers comprising at least two groups: a preferred providers group and a non-preferred providers group, each preferred provider having a distinct preference ranking,**" and

"the online travel service exchanger being further configured to attempt to match the offer with each preferred provider in the preferred providers group in **descending order of preference.**"

As previously discussed, Walker et al. fail to disclose two distinct groups of providers for providing sought-for goods, specifically a preferred provider group and a non-preferred provider group. Also previously discussed, Walker et al. fail to disclose preference rankings among the group of preferred providers, and that each preferred provider has a distinct preference ranking. As Walker et al. fail to disclose preference rankings, it also follows that Walker et al. fail to disclose that each preferred provider has a distinct preference ranking. Also previously discussed, Walker fail to disclose a system that attempts to repeatedly match an offer from providers in the preferred providers group in **descending order according to preference.**

While Walker et al. may disclose that a CPO is satisfied by the first qualified seller to respond, applicants assert that this is patentably distinct from attempting to match an offer with each preferred provider in order of their distinct preference ranking. As discussed above, an implicit aspect of a preference ranking associated with each preferred provider is that the preferred provider receives an exclusive opportunity to respond to a consumer's offer, without concern for being the first to respond. Thus, in contrast to the present invention, Walker et al.

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completely fail to disclose any preferential treatment, instead disclosing a system that simply awards the consumer's offer to the fastest to respond.

For the reasons described above, applicants respectfully assert that Walker et al. fail to disclose each element of independent Claim 24. Accordingly, applicants request that the 35 U.S.C. § 102(b) rejection of Claim 24 be withdrawn and the claim allowed.

Claims 25-29

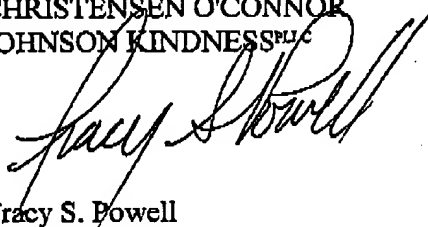
Claims 25-29 depend from Claim 24. Accordingly, for the same reasons described above in regard to Claim 24, applicants assert that Walker et al. fail to disclose each element of these claims, especially when read in conjunction with independent Claim 24. Accordingly, for the same reasons described above, applicants request that the 35 U.S.C. § 102(b) rejection of Claims 25-29 be withdrawn and the claims allowed.

CONCLUSION

In view of the foregoing remarks it is believed that the present application is in condition for allowance. Accordingly, reconsideration and reexamination of the application, as amended, are requested. Allowance of Claims 1-29 at an early date is solicited. If the Examiner has any questions, she is invited to call applicants' attorney at the number listed below.

Respectfully submitted,

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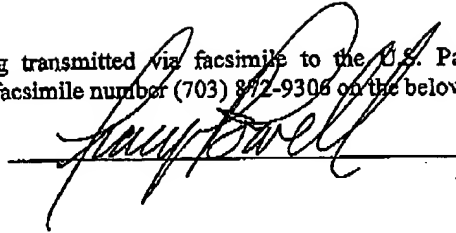


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LEXSEE 94 US 780

COCHRANE v. DEENER.

SUPREME COURT OF THE UNITED STATES

94 U.S. 780; 24 L. Ed. 139; 1876 U.S. LEXIS 1942; 4 Otto 780

OCTOBER, 1876 Term

PRIOR HISTORY: [***1]

APPEAL from the Supreme Court of the District of Columbia.

The case is stated in the opinion of the court.

LexisNexis (TM) HEADNOTES - Core Concepts:

SYLLABUS:

1. The powers and jurisdiction of the Supreme Court of the District of Columbia, in patent cases, are the same, as well in equity as at law, as those of the circuit courts of the United States; and whether a case, involving the validity or the infringement of letters-patent, shall be first tried at law is a matter of discretion and not of jurisdiction.

2. The improvement in processes for manufacturing flour, for which reissued letters-patent No. 5,841 were granted to William F. Cochrane and his assignees, April 21, 1874, being a reissue of letters-patent No. 37,317, granted to him Jan. 6, 1863, does not consist in using drafts or currents of air, but in the process as a whole, comprising the application of the blast, and the carrying off the fine impurities whereby the middlings, after being separated from the other parts, are purified, preparatory to regrounding.

3. A process may be patentable, irrespective of the particular form of the instrumentalities used. If one of the steps of a process be that a certain substance is to be reduced to a powder, it may not [***2] be at all material what instrument or machinery is used to effect that object, whether a hammer, a pestle and mortar, or a mill. Either may be pointed out; but, if the patent is not confined to that particular tool or machine, the use of the

other would be an infringement, the general process being the same.

4. A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts, performed upon the subject-matter, to be transformed and reduced to a different state or thing. If new and useful, it is just as patentable as a piece of machinery. In the language of the patent law, it is an art.

5. The machinery pointed out as suitable to perform the process may or may not be new or patentable, whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.

6. The court holds that reissued letters-patent No. 5,841, bearing date April 21, 1874, for improvements in processes for manufacturing flour; No. 6,030, bearing date Aug. 24, 1870; [***3] No. 6,594 and No. 6,595, bearing date Aug. 17, 1875, for improvements in machines for bolting flour, and issued to William F. Cochrane and his assignees, — are valid, and were infringed by the defendants, in using machines constructed according to reissued letters-patent No. 5,346, bearing date April 1, 1873, being a reissue of letters-patent No. 135,953, bearing date Feb. 18, 1873, and granted to Edward P. Welch and his assignees, for improvements in middlings-purifiers, and being for improvements upon machines patented to Jesse B. Wheeler and Ransom S. Reynolds; but that letters-patent No. 37,319 and No. 37,320, bearing date Jan. 6, 1863, issued to said Cochrane, for improvements in bolting flour, were not infringed.

COUNSEL:

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Submitted on printed arguments by Mr. Walter S. Cox, Mr. Charles F. Blake, and Mr. Rodney Mason for the appellant, and by Mr. A. L. Merriman and Mr. Howard C. Cady for the appellee.

OPINION BY:

BRADLEY

OPINION:

[*781] [**139] MR. JUSTICE BRADLEY delivered the opinion of the court.

This is a suit in equity, instituted in the Supreme Court of the District of Columbia for injunction and relief against an alleged infringement of various patents belonging [***4] to the complainants. The bill was dismissed, and the complainants have appealed.

The patents sued on are six in number, originally five, granted to the appellant Cochrane on the 13th of January, 1863, and numbered respectively 37,317, 37,318, 37,319, 37,320, and 37,321. They all related to an improved method of bolting flour, the first being for the general process, and the others for improvements in the different parts of the machinery rendered necessary in carrying on the process. Three of the original patents, Nos. 37,317, 37,318, and 37,321, were surrendered, and reissues taken in 1874, which reissues were numbered 5,841, 6,029, and 6,030, the first being for the process, and the other two for portions of the machinery. Reissue 6,029, being in place of the original patent numbered 37,321, was also subsequently [*782] surrendered, and two new reissued patents substituted therefor, numbered 6,594 and 6,595.

The case has been mainly argued on the question of infringement, the defendants using a bolting apparatus constructed according to letters-patent issued to Edward P. Welch in April, 1873, for improvements upon machines patented to Jesse B. Wheeler and Ransom S. Reynolds, [***5] which, as well as the process employed, they contend, are radically different from the apparatus and process of Cochrane.

A preliminary question is raised with regard to the jurisdiction of the court below to hear the case on a bill in equity, before a determination of the rights of the parties in an action at law.

The powers of the Supreme Court of the District of Columbia in patent cases are the same as those of the circuit courts of the United States. See Revised Statutes relating to the District of Columbia, sects. 760, 764.

The circuit courts were first invested with equity jurisdiction in patent cases by the act of Feb. 15, 1819,

which declared that these courts should have "original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, should have authority to grant injunctions, according to the course and principles of courts of equity," &c.

This law was substantially re-enacted in the seventeenth [***6] section of the patent law of July 4, 1836, and the fifty-fifth section of that of July 8, 1870, special powers to assess damages in equity cases being also conferred by the latter act.

Before the act of 1819 was passed, the circuit courts had cognizance of actions at law brought to recover damages for the infringement of patents, but not of suits in equity in relation thereto, unless the parties happened to be citizens of different States. Phillips on Pat. 379; [**140] *Livingston v. Van Ingen*, 1 Paine, 54; *Sullivan v. Redfield*, id. 447. Under that act and the subsequent acts in which it became incorporated, bills in equity for injunction, discovery, and account have constantly [*783] been sustained, frequently without any previous action at law. As said by Mr. Justice Grier, in a case decided at the circuit, "It is true that, in England, the chancellor will generally not grant a final and perpetual injunction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided. But even there the rule is not universal: it is a practice founded more on convenience than necessity. It always [***7] rests in the sound discretion of the court. A trial at law is ordered by a chancellor to inform his conscience, not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact or of legal titles. In the United States, the practice is by no means so general as in England." *Goodyear v. Day*, 2 Wall. Jr. 296. Subsequently, in the case of *Sickles v. Gloucester Manufacturing Co.*, 3 id. 196, the same judge said: "The courts of the United States have their jurisdiction over controversies of this nature by statute, and do not exercise it merely as ancillary to a court of law." And, after quoting the statute, he proceeds: "Having such original cognizance, . . . the courts of the United States do not, in all cases, require a verdict at law on the title, before granting a final injunction, or concede a right to every party to have every issue as to originality or infringement tried by a jury."

The position of Mr. Justice Grier is undoubtedly true, that whether a case shall be first tried at law is a matter of discretion, and not of jurisdiction; and in this matter the courts of the United States, sitting as courts of [***8] equity in patent cases, are much less disposed

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than the English courts are to send parties to a jury before assuming to decide upon the merits.

But the counsel for the defendants suggest that the Revised Statutes have not preserved in entirety the previous enactments on this subject, but have omitted the vesting of original cognizance in the circuit courts sitting as courts of equity in patent cases. From a careful consideration, however, of all the sections of the Revised Statutes on the subject, we think that no intention is evinced to make any change in the law. The original enactments are separated into distinct parts, and somewhat condensed; but the substance of them is retained. By sect. 629, the circuit courts are invested with jurisdiction, among [*784] other things, "Ninth, of all suits at law or in equity arising under the patent or copyright laws of the United States." And, by sect. 4921, it is declared, that "the several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity," &c., following precisely the language used in the act of 1870, the last previous [***9] revision of this branch of the law. The grant of jurisdiction is as broad and general as it could well be, and the mode of exercising it is prescribed in precisely the same terms as in previous statutes.

In the present case, we see no special reason for sending the case to a court of law or to a jury for trial. There are no such issues depending upon the credibility of witnesses, or on the intricacy of machinery, as to make the case susceptible of easier solution or greater certainty as to the truth before such a tribunal than it admits of when presented to the consideration of a chancellor. It would, perhaps, be desirable if all cases of this sort could be referred to a commission of intelligent experts and practical men to report their opinion thereon, with their reasons, for the final action of the court. A proceeding of this kind was probably in the mind of Congress in passing the act of Feb. 16, 1875, authorizing a reference to a jury of five persons. Neither courts nor ordinary juries are perfectly adapted to the investigation of mechanical and scientific questions. The court below, however, exercised its discretion to decide the case upon its merits, without the aid [***10] of a jury of any sort, and their action is not a ground of appeal. If we were convinced, however, that the case was not properly decided, and could not be properly decided without such a reference, we might undoubtedly, in the exercise of our own discretion, remand it to the court below for that purpose. But we see nothing in the questions raised which require that such a course should be adopted.

The principal patent sued on in this case was granted on the 21st of April, 1874, being a reissue of a patent granted to William F. Cochrane on the 6th of January, 1863. The original patent was numbered 37,317, and the

reissue 5,841. The alleged invention is for a process in manufacturing flour. The patentee, in his specification, says: "The object of my invention [*785] was to increase the production of the best quality of flour, and my improvement consisted in separating from the meal first the superfine flour, and then the pulverulent impurities mingled with the flour-producing portions of the middlingsmeal, so as to make 'white' or 'purified' middlings, which, when reground and rebolted, would yield pure white flour, which, when added to the superfine, would improve the quality [***11] of the flour resulting from their union, instead of deteriorating its quality, as had heretofore been the case when the middlings flour was mingled with the superfine." The process employed for producing the result here indicated is then described. It consists in passing the ground meal through a series of bolting-reels clothed with cloth of progressively finer meshes, which pass the superfine flour and retard the escape of the finer and lighter impurities; and, at the same time, subjecting the meal to blasts or currents of air introduced by hollow perforated shafts furnished with pipes so disposed that the force of the blast may act close to the surface of the bolting-cloth; the bolting-chest having an opening at the top for the escape of the air, and of the finer and lighter particles therewith, through a chamber where the particles are arrested, whilst the floor and sides of each compartment of the chest are made close, so as to prevent the escape of the air in any other direction than through the said opening. By this means, the superfine flour is separated, and the fine and light specks and impurities, which ordinarily adhere to the middlings and degrade the flour produced therefrom, [***12] are got rid of; and when [**141] the middlings are now separated from the other portions of the meal, they are white and clean, and capable of being reground and rebolted, so as to produce superfine flour equal in quality and even superior to the first instalment.

This is the process described; but the patentee claims that it is not limited to any special arrangement of machinery. He admits the prior use of currents of air in the interior of the reels, introduced by means of hollow, perforated shafts, for the purpose of keeping back the speck, and increasing the quantity of superfine flour; but not for purifying the middlings preparatory to regrounding. His improvement, therefore, does not consist in using drafts and currents of air, but in the process as a [*786] whole, comprising the application of the blast, and the carrying off of the fine impurities, whereby the middlings are purified preparatory to regrounding after being separated from the other parts.

The defendants deny that they use this process. They purify the middlings of the flour, as before stated, by means of machines constructed according to letters-

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patent issued to Edward P. Welch, in April, 1873, for [***13] improvements upon machines patented to Jesse B. Wheeler and Ransom S. Reynolds.

In this process, reels are not used for purifying the middlings, but a flat and slightly inclined vibrating screen or sieve is used for the purpose; over which the ground meal is passed, and whilst passing is subjected to currents of air blown through a series of pipes situated close underneath the screen; which currents pass up through the screen and through an opening at the top of the chest into a chamber, carrying with them the finer and lighter impurities, whereby the middlings are rendered clean and white, and capable of being reground into superfine flour. The bolting-chest is made tight and close on all sides except the opening at the top, so that the currents of air may be forced to escape by that exit.

Now, except in the use of a flat sieve or screen in place of reels, it is difficult to see any substantial difference between these two methods. The defendants use, in addition, brushes, which revolve on the under side of the screen, so as to keep the meshes thereof constantly clean and free; but this is merely an addition, which does not affect the identity of the two processes in other [***14] particulars. We have substantially the same method of cleaning the middlings preparatory to regrounding by means of currents of air passed through them whilst being bolted, and whilst being confined in a close chest or chamber, said chamber having an opening above for the escape of said currents of air and the impurities with which they become loaded. The middlings being thus purified are reground and rebolted, producing a superfine flour of superior grade, -- a new, useful, and highly valuable result.

The use of a flat screen instead of a revolving reel for bolting and cleaning the middlings is a mere matter of form. It [*787] may be an improved form, and, perhaps, patentable as an improvement; but it is at most an improvement.

The forcing of the air-currents upward through the screen and film of meal carried on it and against the downward fall of the meal, instead of forcing them through the bolting-cloth in the same direction with the meal, is also a mere matter of form, and does not belong to the substance of the process. The substantial operation of the currents of air in both cases is to take up the light impurities and bear them away on the aggregate current through [***15] the open flue, and thus to separate them from the middlings. This, too, may be an improvement on Cochrane's method; but it is only an improvement.

The defendants admit that the process has produced a revolution in the manufacture of flour; but they attribute that revolution to their improvements. It may

be as they say, that it is greatly due to these. But it cannot be seriously denied that Cochrane's invention lies at the bottom of these improvements, is involved in them, and was itself capable of beneficial use, and was put to such use. It had all the elements and circumstances necessary for sustaining the patent, and cannot be appropriated by the defendants, even though supplemented by and enveloped in very important and material improvements of their own.

We do not perceive that the patent of Cogswell and McKiernan, if valid at all as against Cochrane (a point which will be more fully considered hereafter), affects the question in the least. That patent is not at all for the process which Cochrane claims. If valid, and if, in using his process, Cochrane is obliged to use any device secured to Cogswell and McKiernan, it does not detract in the slightest degree from his [***16] own patent. One invention may include within it many others, and each and all may be valid at the same time. This only consequence follows, that each inventor is precluded from using inventions made and patented prior to his own, except by license from the owners thereof. His invention and his patent are equally entitled to protection from infringement, as if they were independent of any connection with them.

That a process may be patentable, irrespective of the particular form of the instrumentalities used, cannot be disputed. If [*788] one of the steps of a process be that a certain substance is to be reduced to a powder, it may not be at all material what instrument or machinery is used to effect that object, whether a hammer, a pestle and mortar, or a mill. Either may be pointed out; but if the patent is not confined to that particular tool or machine, the use of the others would be an infringement, the general process being the same. A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. If new and useful, it is [***17] just as patentable as is a piece of machinery. In the language of the patent law, it is an art. The machinery pointed out as suitable to perform the process may or may not be new or patentable; whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.

The machine patents come next to be considered.

As to number 6,030, which is a reissue of the original patent number 37,318, the defendants clearly [***142] infringe, at least, the last claim, which is in these words: "In combination with the screen incased in a chest, the perforated blast-pipe and the suction-pipe,

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arranged to operate on opposite sides of the screen, substantially as set forth."

As to the patent next in order, namely, the original patent number 37,319, which relates specially to the use of what the patentee calls the pump for introducing the meal into the chest and reels, whilst the valve arrangement used by the defendants may be an equivalent in the general combination with the said pump described by Cochrane, [***18] yet, taken by themselves, as separate pieces of machinery, they are not the same, and the use of the one is not an infringement of a patent for the other. *Curtis*, sect. 332; *Foster v. Moore*, 1 *Curtis*, C.C. 279. Nor can we perceive that the defendants infringe the next patent, number 37,320, which is for certain combinations of machinery, including the bolting-reels, dead-air chambers therein, slotted shaft, and reciprocating board for discharging the meal, &c., which it is unnecessary to describe more particularly.

[*789] The two remaining patents, numbered 6,594 and 6,595, being reissues of original patent number 37,321, are for combinations of essential parts of the machinery required for bolting flour and purifying the middlings according to the general process described in the first patent. The principal claim of the original patent was for the condensing or collecting chamber, through which the currents of air, on leaving the bolting-chest, make their escape, and where they leave the fine particles with which they become loaded. This claim, it is said, was found to be too broad, inasmuch as a collecting chamber, somewhat similar, had been used in another connection, [***19] though not in the combinations presented in Cochrane's bolting process. The original patent, therefore, was surrendered, and the two patents now under consideration were issued in place thereof, claiming the use of the collecting chamber in combination with the various material parts of the bolting apparatus. The reissue, number 6,594, contains three claims, and number 6,595, one claim.

The first claim of reissue number 6,594 is for the collecting chamber (used for the purpose aforesaid) in combination with the bolter, air-pipes, and valves for feeding and delivering the meal without allowing the air to pass therewith. Now, although the defendants use a flat bolter instead of a reel, and use different kinds of valves for feeding and delivering the meal without allowing the air to pass, yet they employ the combination of devices described in this claim. They use the collecting chamber for the same purpose as that pointed out in the patent, and use it in connection with a bolter, air-pipes, and valves for feeding and delivering the meal without allowing the air to pass therewith, each effecting the same separate purpose, and all combined effecting the same general purpose, which [***20] the like parts

are intended to accomplish in Cochrane's bolting apparatus. Though some of the corresponding parts of the machinery, designated in this combination, are not the same in point of form in the two bolting apparatuses, and, separately considered, could not be regarded as identical or conflicting, yet having the same purpose in the combination, and effecting that purpose in substantially the same manner, they are the equivalents of each other in that regard. The claim [*790] of the patent is not confined to any particular form of apparatus, but (in regard to the valves, for example) embraces generally any valves for feeding and delivering the meal without allowing the air to pass through. We are of opinion, therefore, that the combination here claimed is infringed by the apparatus used by the defendants.

It is unnecessary to make a separate examination of the other claims embraced in the two patents under consideration. They are all susceptible of the same observations which we have made with regard to the first claim. In our opinion, the defendants do infringe them.

But a question is raised with regard to Cochrane's priority of invention. A patent was granted [***21] on the 12th of June, 1860, to Mortimer C. Cogswell and John McKiernan for improvements in ventilated bolting-chests, which, it is contended, antedates and nullifies Cochrane's apparatus as patented to him in the original patent 37,321, and in the two reissues thereof before mentioned. This patent (of Cogswell and McKiernan) we have examined, and find that it does contain five of the elements embraced in those reissues; namely (besides the bolting-chest and bolter, which are always used), it contains the perforated air-pipe extending inside of the bolting-reel, the fan for producing a blast of air therein, and a collecting-chamber for arresting the flour carried off by the blast. The purpose was simply to cool the meal and keep the bolting-cloths dry. The flour which collected in the chamber was returned to the chest. The parts contained in this apparatus are those which are patented in combination in Cochrane's reissue 6,595, which was separated, it is said, from reissue 6,594 on account of this patent of Cogswell and McKiernan. The combinations patented in reissue 6,594 embrace other parts not contained in Cogswell and McKiernan's patent, and the defendants contend that this [***22] reissue is void, as not being sustained by the original patent 37,321.

The latter position, we think, is untenable. Cochrane's apparatus, as exhibited in his model, and described in his original patent, and in the series of patents taken out at the same time, all having relation to the same general process, and referred to in patent 37,321, contained all the parts which go to make the [*791] combination claimed in reissue number 6,594.

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We see no reason, therefore, why such reissue was not properly granted to him by the Patent Office, the claim being, in fact, a much narrower one than that of the original patent.

The same observations apply to reissue number 6,595. But, as to that, as before stated, the particular elements of the combination claimed in it are found in Cogswell and McKiernan's machine; and if this is entitled to the precedence over Cochrane's, reissue number 6,595 is void. He contends that it is not entitled to such precedence; but that, in fact, Cogswell and McKiernan surreptitiously obtained a patent for his invention. We have examined the evidence relating to this matter, and are satisfied that the improvement claimed by Cochrane was his invention; that [***23] Cogswell and McKiernan obtained their knowledge of it from him; and that there is nothing connected with their patent which [**143] ought to invalidate the reissued patent in question.

A French patent, dated 27th of September, 1860, granted to one Perigault, is also referred to as anticipating the combinations in these patents. But it being shown that Cochrane's invention was actually made before that date, the point was not pressed in the argument. By the act of 1870, a foreign patent, in order to invalidate an American patent, must antedate the invention patented.

Our conclusion is, that the patent for the process, being reissue number 5,841, and the several reissued patents for combinations of mechanical devices, numbered respectively 6,030, 6,594, and 6,595, are valid patents, and are infringed by the defendants; and that the other two patents named in the bill of complaint, numbered respectively 37,319 and 37,320, are not infringed by the defendants.

Decree reversed, and cause remanded with directions to enter a decree for the complainants, and to proceed therein in conformity with this opinion.

DISSENTBY:

CLIFFORD

DISSENT:

MR. JUSTICE CLIFFORD, with whom concurred MR. [***24] JUSTICE STRONG, dissenting.

I dissent from the opinion and judgment of the court in this case, for the following reasons: --

[*792] 1. Because the mechanical means employed by the respondents to effect the result are substantially different from those described in the complainants' patent.

2. Because the process employed by the respondents to manufacture the described product is materially and substantially different from the patented process employed by the complainants.

3. Because the respondents do not infringe the combination of mechanism patented and employed by the complainants. *Prouy v. Ruggles*, 16 Pet. 341; *Vance v. Campbell*, 1 Black, 428; *Gill v. Wells*, 22 Wall. 26.

4. Because the respondents do not infringe the process patented by the complainants, the rule being, that a process, like a combination, is an entirety, and that the charge of infringement in such a case is not made out unless it is alleged and proved that the entire process is employed by the respondents. *Howe v. Abbott*, 2 Story, C.C. 194; [***25] *Gould v. Rees*, 15 Wall. 193.